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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/729,162

Filing Date: December 05, 2003

Appellant(s): WALKER, ERIC

Jessica Costa
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 29 November 2007 appealing from the Office action mailed 20 November 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

- Sams Publishing, "Sams Teach Yourself Microsoft Publisher 2000 in 10 Minutes", Sams Publishing, published 5/6/1999, pp 1-16

- Microsoft, "Digital Photography Glossary of Terms", 5/1/2002, Microsoft, pp 1-3
<http://www.microsoft.com/windowsxp/using/digitalphotography/glossary/default.mspx?pf=true>
- Coloring.com, "Coloring.com - free online interactive coloring pages and coloring book", Coloring.com, 11/29/2002, pp 1-31,
<http://www.coloring.com>, <http://web.archive.org/web/20021129165101/http://www.coloring.com/>

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 3-4, 6-8, 10, 16-18, and 20-21 remain rejected under 35 U.S.C. 102(b) as being anticipated by Coloring.com (Coloring.com, "Coloring.com - free online interactive coloring pages and coloring books", pp 1-27, 28-31)

Examiner provides printouts (pgs 1-16) that Coloring.com of showing the features and functionality disclosed to as early as November 29, 2002. Furthermore, Examiner used Screenshots taken on 8/1/2006 to show the complete and working functionality of the features within Coloring.com that has been accessible since at least November 29, 2002. In addition, Examiner provided additional pages pp 28-31 of screenshots of Coloring.com, showing the features and functionality disclosed to as early as November 29, 2002, taken on 11/9/2006.

As per independent claim 1, Coloring.com discloses a method comprising:

- associating at least one color with a markup language element capable of accepting image content, (pp 6, 7, 8, 9-16,17-18: discloses a web site, using a browser, having the ability to show markup elements (pp 6, list of the images or graphics the user may choose), wherein each markup element is an graphic or image being shown capable of being separately shown to the user (pp 8 discloses on embodiment) of receiving colors (color is an attribute of an image, thus image content) from the palette on the left menu of colors. PP 9-16, and 18 discloses the source code behind the web page of the markup language element (graphic or image) wherein in its visual form, displaying a graphic or image that contain many patterns and shapes used to form a visual figure, which a person is capable of identifying, e.g. a rabbit on pp 8, on a different colored background. The code written in HTML enables the graphic or image to accept colors. In addition, a user can choose among the colors on the palette to the left .(pp 8, 17))
- applying a grayscale image as content of the element, and (Coloring.com discloses a grayscale images wherein only the two colors are shown, white and black; wherein black and white images are a form of grayscale images. Thus, the grayscale image is used as content for the element shown in pp 8, 17 of the web page.
- applying the at least one color associated with the element as at least one component color of the content image. (A user selects a color on the color palette on the menu on the left. Then once the color has been selected, the

user clicks on a pattern of a portion of the image to fill it with the selected color. Doing so fills the up that portion or pattern with that color shown in pp 20-22.)

As per dependent claim 3, Coloring.com discloses a method further:

- displaying at least the content image to a user (pp 17)
- providing a color palette containing a plurality of individually selectable colors, (pp 20, 22 shows a palette full of a plurality of individual selectable colors on the left side)
- allowing the user to select a color from the palette, (pp 20, 23: user able to select a color)
- after the selection of a color by the user, modifying the content image by replacing one of the color components of the content image with the selected color, and displaying at least the modified content image to the user. (pp 20-22, 23-25: user selects a color, clicks on the already modified portion of the content of colored filled in from pp 22, wherein pp 25 discloses the new color replacing the old color. pp 20-22 discloses replacing the portion of content that is white with a color from the palette)

As per dependent claim 4, Coloring.com discloses a method wherein the element is a shape and the grayscale is applied as pattern fill content of the shape. (eg. Pp17 discloses an image as a form of grayscale that contains multiple shapes that capable of

being pattern filled by a color within each shape. (pp 20-22 discloses an example of pattern filling with a color of a element on the grayscale image)

As per independent claim 6, Claim 6 recites similar limitations as in claim 1 and is similar rejected under rationale. Furthermore, Coloring.com discloses a system:

- a server and a color image software system encoded on one or more computer readable media (e.g. FIG 4 discloses a browser connected to a web page based on the URL supplied to the browser. It is inherent browser connect to servers to download web pages from the servers' data storage device to the computer the browser recites, therefore the browser downloads the web page (Coloring.com) from a server data storage device and is provided to the user computer through the browser. In addition, the interaction between the user and the functionality of Coloring.com is a system.)
- one or more markup language elements having at least one associated color attribute and having grayscale content image. (FIG 8 discloses a markup language element that is a graphic or image wherein it is a grayscale content image. Since grayscale content images contain color attribute such as black and white, thus Coloring.com images are considered grayscale images associated with a color attribute)
- supplying at least the element to a user computer for displaying to a user (FIG 4: Displays image to the user)

As per dependent claim 7, Coloring.com discloses system further comprising: at least one color selection tool, means for allowing a user to select at least one color with the color selection tool, and means for applying the at least one selected color as at least one color component of the content image. (pp20-22: A user selects a color on the color palette on the menu on the left. Then once the color has been selected, the user clicks on a pattern of a portion of the image to fill it with the selected color. Doing so fills the up that portion or pattern with that color shown)

As per dependent claim 8, claim 8 recites similar limitations as in claim 4 and is similarly rejected under rationale.

As per independent claim 10, Claim 10 recites similar limitations as in claim 1, 3 and 6 and is similar rejected under rationale.

As per independent claim 16, Coloring.com recites similar limitations as in Claim 1 and 10, and is similar rejected under rationale. Furthermore, Coloring.com discloses a method comprising:

- receiving electronic product desire information, the information including identifiers of a plurality of colors, and (pp 8, 9-16,17-18: Coloring.com discloses a palette of colors that enable a user to from on the left. Therefore, Coloring.com discloses “receiving electronic product design information” as stated)
- processing the received information in the browser program to display an electronic product design to a user, the electronic design including at least the at least one element, the image content of the at least one element being

generated by applying at least one color from the plurality of colors as at least one color attribute of the at least one element and using the at least color attribute of the at least one element one component color of the grayscale image content of the element.(Using Internet Explorer as shown to access Coloring.com, Coloring.com discloses a “electronic design” that includes an image or graphic that has one color replaced by one of the colors selected from the color palette. (pp 20-22)

As per dependent claim 17, Claim 17 recites similar limitations as in claim 3 and is similar rejected under rationale.

As per dependent claim 18, Claim 18 recites similar limitations as in claim 1 and is similar rejected under rationale.

As per dependent claim 20, Claim 20 recites similar limitations as in claim 16 and is similar rejected under rationale.

As per dependent claim 21, Coloring.com discloses allowing the user to place an order for the production of one or more products from the electronic product design. (Coloring.com discloses the ability to request print the electronic design after a color has been replaced or in other words place an order for the production (printed copy) of the electronic product design. PP 28 shows the a link that enables a user to print the graphic. Clicking on the link shows pp 29 that shows just the modified image with colors that were added. (PP 29 shows a screenshot taken on 11/9/2006 to show the complete and working functionality of the feature within coloring.com that been accessible since at least November 29, 2002.) Then using the File>Print (shown on pp 30), which pops

up a print dialog box (pp 31), a user can “order” a number of printed copies (products) of the electronic design.)

Claims 2, 5, 9, 12, 15, and 19 remain rejected under 35 U.S.C. 103(a) as being unpatentable over (Coloring.com, “Coloring.com - free online interactive coloring pages and coloring books”, 11/29/2002, pp 1-25) in further in view of (Sams Publishing, “Sams Teach Yourself Microsoft Publisher 2000 in 10 Minutes”, published 5/6/1999, printed pages 1-11, 12-16)

As per dependent claim 2, Coloring.com discloses a method further comprising:

- displaying at least the content image to a user (pp 20, or 22)
- modifying the content image by replacing one of the color components of the content image with at least one of the selected colors, and displaying the at least the modified content image to the user. (pp 20-22, 23-25: user selects a color, clicks on the already modified portion of the content of colored filled in from pp 22, wherein pp 25 discloses the new color replacing the old color. pp 20-22 discloses replacing the portion of content that is white with a color from the palette.)

However, Coloring.com fails to specifically disclose providing a plurality of color groups, allowing the user to select a group from the plurality of groups, and after the selection of a group by the user modifying the content image by replacing one of the color components of the content image with at least one of the selected colors in the selected group. However, Sams Publishing discloses one of Microsoft Publisher 2000

feature that provides a plurality of color schemes which the user is able to choose a scheme for coloring purposes. (pp 4) It would have been obvious to one of ordinary skill in the art at the time of Appellant's invention to have modified Coloring.com ability to color images on a web page with Sams Publishing's disclosure of Microsoft Publisher 2000 ability to choose coloring schemes since it would provided the user options of to make personalized customizable publication based on the users interests. Thus, after selecting a color scheme, a user would be able to select a color from the selected scheme to modified the content image.

As per dependent claim 5 and 19, Coloring.com discloses the ability to save the modified graphic or image by right-clicking and saving it to a user's system. (pp 26-27) However, Coloring.com fails to disclose incorporating the content image into an electronic product design, displaying the electronic product design to the user, and allowing the user to place an order for the production of one or more products from the electronic product design. However, Sams Publishing discloses that Microsoft Publisher 2000, hereinafter "Publisher", has the ability to create publication pages that include flyers, postcards etc. (pp 1-7) Thus, a user can create a flyer using the publication wizard, then use the insert picture option. (pp 8-10) Doing so, incorporates the saved modified image from the user's system into Publisher's flyer where it is displayed to the user. In addition, a user can request to print the publication which allows the user to request the publication on paper (product) through the Print options of Microsoft Publisher 2000 (pp 12 –16)

It would have been obvious to one of ordinary skill in the art at the time of

Appellant's invention to have modified Coloring.com's method of coloring grayscale images to include Sam's Publishing disclosure of Publisher that enables a user to incorporate images and graphics into a publication since Sams Publishing's disclosure of Publisher provides the benefit of using Publisher which is an easy-to-use desktop publishing tool that allows a user to create variety types of publications that include importing images or graphics to make it look professional.

As per dependent claim 9, claim 9 recites similar limitations as in claim 5 and is similarly rejected under rationale.

As per dependent claim 12, claim 12 recites similar limitations as in claim 5 and is similarly rejected under rationale.

As per independent claim 15, Claim 15 recites similar limitations as in claim 3 and is similar rejected under rationale.

(10) Response to Argument

On pages 12-14, 16-17, in reference to independent claims 1, 6, and 10, Appellant argues that Coloring.com does not teach the limitation "applying a grayscale image as content of the element" wherein the Appellant argues grayscale "refers" to "image content intended to be rendered in multiple color tones based on the combination of two component colors" and not just two colors of black and white being shown. (Page 13, first paragraph) In addition, Appellant argues Coloring.com does not teach or suggest an image container having grayscale image content. However, the Examiner disagrees.

In response to Appellant's argument that the references fail to show certain features of Appellant's invention, it is noted that the features upon which Appellant relies (i.e., image content intended to be rendered in multiple color tones based on the combination of two component colors ; an image container having grayscale image content) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

According to the claim language in the claim limitation, the term "grayscale" is vaguely defined within the claims. Appellant argues that grayscale "refers" to "image content intended to be rendered in multiple color tones based on the combination of two component colors" in the specification; however, the claim limitations do not give a definitive descriptive definition of the term "grayscale". As stated in the previous Office action, the Examiner provided an online definition of the term "grayscale" by Microsoft's Digital Photography Glossary (hereinafter Microsoft) since the claim did not fully define the term "grayscale." Microsoft discloses on page 2 under the definition of the term "grayscale" being defined as a photo made up of varying tones of black and white wherein **grayscale is synonymous with black and white**. Therefore, grayscale images have the ability to be viewed as black and white images according to provided reference. Furthermore, the colors of black and white are a subset of grayscale, being the extreme tones of grayscales; therefore, a grayscale image has the ability of only using white at one extreme and only using black at the other extreme. Thus, a black and white image viewed as a grayscale image. In addition, there are different levels of

grayscale based on the number of bits used in a grayscale image. In one embodiment, a grayscale level for a grayscale image using one image bit only contains black and white in the image. However, since the claim limitation does not indicate the level of grayscale used in the grayscale image, i.e. containing more than one bit, then the level of grayscale for grayscale image is containing one image bit is being viewed by the Examiner. Overall, since the Appellant does not disclose a narrow limitation defining grayscale within the claims, then a grayscale image has the ability to be viewed as a black and white image. Therefore, Coloring.com discloses a grayscale images wherein only the two colors are shown, white and black; wherein black and white images are a form of grayscale images. Thus, the grayscale image is used as content for the element shown in pp 8, 17 of the web page.

Furthermore, on pages 14-15, in reference to the independent claims, Appellant argues that Coloring.com fails to teach or suggest the claim limitation “applying the at least one color associated with the element as at least one component color of the content image” wherein Appellant is stating the claim limitation is viewed as “allowing a user to select at least one component color of a pair of grayscale component colors and apply it to the grayscale image such that the grayscale image will be rendered in multiple color tones based on the combination of the selected component color and one other color”. However, the Examiner disagrees.

In response to Appellant's argument that the references fail to show certain features of Appellant's invention, it is noted that the features upon which Appellant relies

(i.e., allowing a user to select at least one component color of a pair of grayscale component colors and apply it to the grayscale image such that the grayscale image will be rendered in multiple color tones based on the combination of the selected component color and one other color) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Based on the written claim language of the claim limitation, the claim limitation does not say the component color is a grayscale color, wherein the selected component color is of a pair of grayscale component colors nor does it imply that the selected is a grayscale color. The Examiner views the claim limitation as any new color replacing the current color of the image wherein the new coloe becomes the component color of the image. Thus, Coloring.com discloses the limitation wherein an image written in a markup language has the ability to accept a new color to replace an existing color presented in the image previously. In further detail, Coloring.com, as shown on pp 6, 7, 8, 9-16,17-18, discloses a web site, using a browser, having the ability to show markup elements (pp 6, list of the images or graphics the user may choose), wherein each markup element is an graphic or image being shown capable of being separately shown to the user (pp 8 discloses on embodiment) of receiving colors (color is an attribute of an image, thus image content) from the palette on the left menu of colors. Furthermore, Coloring.com, as shown in pp 9-16, and 18, discloses the source code behind the web page of the markup language element (graphic or image) wherein in its visual form,

displays a graphic or image that contain many patterns and shapes used to form a visual figure, which a person is capable of identifying, e.g. a rabbit on pp 8, on a different colored background. The image has itself has different mapping zones with the use JavaScript to provide further functionality with the use of coloring of the graphic or image (e.g. bunny image). The code written in HTML enables the graphic or image to accept colors. Thus, despite, having multiple mapping zones, the zones make up one overall element that is capable of having a color be applied to image to become a component color of the image In addition, a user can choose among the colors on the palette to the left .(pp 8, 17)

Second, Coloring.com discloses the ability of a user to select a color on the color palette on the menu on the left. Then once the color has been selected, the user clicks on a pattern of a portion of the image to fill it with the selected color. Doing so fills the up that portion or pattern with that color as shown in pp 20-22.

Therefore, Coloring.com teaches the limitation “applying the at least one color associated with the element as at least one component color of the content image.”

On page 16, in reference to dependent claim 3, Appellant argues that Coloring.com does not teach or suggest the limitation “displaying at least the content image to a user, providing a color palette containing a plurality of individually selectable colors, allowing the user to select a color from the palette, after the selection of a color by the user, modifying the content image by replacing one of the color components of the content image with the selected color” wherein Appellant argues that Coloring.com

doesn't disclose more than one color being selected at a time or the selected color is used to fill the entire image container and not used as one of the two color components for a grayscale image. However, the Examiner disagrees.

In response to Appellant's argument that the references fail to show certain features of Appellant's invention, it is noted that the features upon which Appellant relies (i.e., more than one color is selected at a time or the selected color is used to fill the entire image container and not used as one of the two color components for a grayscale image.) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

As disclosed above in the previous argument, the claim limitations do not specifically state that the color component is a grayscale component nor do the limitations disclose more than one color is selected at a given time. Therefore, based on the written claim language of the claim limitations, Coloring.com disclosing the limitations wherein displaying at least the content image to a user (pp 17, discloses an content image of a rabbit to the user display), providing a color palette containing a plurality of individually selectable colors, (pp 20, 22 shows a palette full of a plurality of individual selectable colors on the left side), allowing the user to select a color from the palette, (pp 20, 23: user able to select a color from the color palette), after the selection of a color by the user, modifying the content image by replacing one of the color components of the content image with the selected color, and displaying at least the modified content image to the user. (pp 20-22, 23-25: the user selects a color from the

color palette, clicks on the already modified portion of the content of colored filled in from pp 22, wherein pp 25 discloses the new color replacing the old color. In addition pp 20-22 discloses replacing the portion of content that was originally white with a new color that was selected from the palette). Thus, Coloring.com teaches these limitations.

On page 18, in reference to claim 21, Appellant argues that Coloring.com does not teach or suggest the limitation “allowing the user to place an order for the production of one or more products from the electronic product design” saying Coloring.com is silent on this feature. However, the Examiner disagrees.

Appellant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made.

Appellant's argument fails to disclose how Coloring.com is silent on this issue since Appellant disclose not fully describe what the limitation means, or involve any supporting evidence from the specification stating or describing what type of products are ordered from the design. Therefore, Coloring.com discloses the ability to request print the electronic design after a color has been replaced or in other words place an order for the production (printed copy) of the electronic product design. PP 28 shows a link that enables a user to print the graphic. Clicking on the link shows pp 29 that shows just the modified image with colors that were added. (PP 29 shows a screenshot taken on 11/9/2006 to show the complete and working functionality of the feature within coloring.com that been accessible since at least November 29, 2002.) Then using the

File>Print (shown on pp 30), which pops up a print dialog box (pp 31), a user can "order" a number of printed copies (products) of the electronic design. Therefore, Coloring.com is not silent on the issue as Appellant allegedly claims.

On pages 18-19, in reference to the independent claims, Appellant argues that Sams Publishing fails to teach or suggest the claims limitations. However, the Examiner did not use the reference of Sams Publishing for the rejection of the independent claims in the previous Office Action, wherein the Examiner solely rejected the independent claims with Coloring.com, and therefore, will not view the reference of Sams Publishing into consideration within the arguments of the independent claims.

On page 20, in reference to dependent claim 2, Appellant argues that Coloring.com nor Sams Publishing teach or suggest the limitations, "providing a plurality of color groups, allowing the user to select a group from the plurality of groups, after the selection of a group by the user, modifying the content image by replacing at least one of the color components of the content image with at least one of the colors in the selected group", wherein the Appellant argues that neither reference discloses more than one color is selected at a time and none of the colors associated with any other of the colors in groups. However, the Examiner disagrees.

In response to Appellant's argument that the references fail to show certain features of Appellant's invention, it is noted that the features upon which Appellant relies (i.e., more than one color is selected at a time and none of the colors associated with

any other of the colors in groups) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

As disclose above in the previous argument, the claim limitations do not specifically state that the color component is a grayscale component nor do the limitations disclose more than one color is selected at a given time. Therefore, based on the written claim language of the claim limitations, Coloring.com disclosing modifying the content image by replacing one of the color components of the content image with at least one of the selected colors, and displaying the at least the modified content image to the user. (pp 20-22, 23-25: the user selects a color from the color palette, clicks on the already modified portion of the content of colored filled in from pp 22, wherein pp 25 discloses the new color replacing the old color. In addition pp 20-22 discloses replacing the portion of content that was originally white with a new color that was selected from the palette)

However, the Examiner agrees that Coloring.com fails to disclose providing a plurality of color groups, allowing the user to select a group from the plurality of groups, and after the selection of a group by the user modifying the content image by replacing one of the color components of the content image with at least one of the selected colors in the selected group. However, Sams Publishing discloses one of Microsoft Publisher 2000 feature that provides a plurality of color schemes which the user is able to choose a scheme for coloring purposes. (pg 4) Sams Publishing discloses a plurality

of color schemes (groups) to the user in which the user is allowed to select a group of colors from the plurality of groups and use in conjunction with Coloring.com. Therefore, It would have been obvious to one of ordinary skill in the art at the time of Appellant's invention to have modified Coloring.com ability to color images on a web page with Sams Publishing's disclosure of Microsoft Publisher 2000 ability to choose coloring schemes since it would provided the user options of to make personalized customizable publication based on the users interests. Thus, after selecting a color scheme, a user would be able to select a color from the selected scheme to modified the content image. Thus, Coloring.com and Sams Publishing teaches the limitations.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

David Faber

/David Faber/

Examiner, Art Unit 2178

Conferees:

/Stephen S. Hong/

Supervisory Patent Examiner, Art Unit 2178

Stephen Hong, Supervisory Patent Examiner for Group Art Unit 2178

Doug Hutton, JR, Supervisory Patent Examiner for Group Art Unit 2176

/Doug Hutton/
Doug Hutton
Supervisory Primary Examiner
Technology Center 2100